

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Number : 09/883,502 Confirmation No.: 8691
Applicant : Jeffrey A. Bedell et al.
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Title : REPORT SYSTEM AND METHOD USING PROMPT OBJECTS
TC/Art Unit : 2178
Examiner: : Cong-Lac Huynh
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REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

Pursuant to the Pre-Appeal Brief Conference Pilot Program announced in the Official Gazette, Applicants hereby request a pre-appeal brief conference in the above-referenced case. No amendments are being filed with this request. Additionally, this request is being filed with a Notice of Appeal.

This application is appropriate for a pre-appeal brief conference. A brief history of this application and why applicants believe that an appeal will succeed are set forth below.

This application was filed over seven years ago on June 19, 2001. On November 3, 2004, an initial action was issued rejecting claims 1-28 using U.S. Patent No. 6,668,253 to Thompson et al. ("Thompson") based on section 103. On February 3, 2005, Applicants filed a responsive amendment to successfully overcome the rejection. On May 20, 2005, a Final Rejection was issued rejecting claims 1-28 using U.S. Publication No. 2002/0069207 to Alexander et al. ("Alexander") under section 102(e). Despite filing three (3) Requests for Continued Examination (RCEs), the Office has maintained the same grounds of rejection using the same reference. Even though Applicants have made several attempts to further clarify important distinctions of the present invention in at least each of the RCEs, the Office has continued to misapply the Alexander reference. In the most recent rejection, a Final Rejection ("Office

Action”) dated December 2, 2008 has now been improperly entered against claims 1-28 under section 102(e).

Despite clearly indicating the deficiencies in the proposed rejection, the Office continues to misconstrue the Alexander reference and misapplies its obligation to show that all the claimed elements are taught by the reference.

Specifically, independent claim 1 recites:

A prompt object on a computer-readable medium used in creating a report to be executed in a reporting system, wherein the report may specify a prompt object as a property of the report, the *prompt object* comprising:

a *question* to be asked of a user;

a *prompt type*; and

at least one *validation property*;

wherein the prompt object is used in creating a report to be executed in a reporting system, wherein the report may specify a prompt object as a property of the report, and wherein the prompt object is an object separate from the report such that prompt object may be used more than once in a single report or may be used in more than one report (emphasis added).

Alexander does not disclose at least a “prompt object comprising: ... a prompt type; and at least one validation property,” as expressly recited in claim 1.

On page 3, the Office Action alleges that Alexander teaches these features in paragraphs [0027], [0029], and [0034]. However, in these paragraphs, Alexander discloses nothing more than a survey created by a survey manager. In fact, page 3 of the Office Action improperly equates the survey of Alexander with the claimed prompt object when it states that “survey, which is equivalent to a prompt object, is classified by types such as medical, political, or product preference.” The Office Action further alleges that “values assigned to the answers” are allegedly for “validating right answers” to constitute at least one validation property. Office Action at p. 3. Applicants respectfully disagree.

Contrary to the statements made in the Office Action, assigning different types of answers to questions in a survey does not imply that the survey includes a prompt type and a validation property for a data type of the answer. In fact, Alexander does not even use the terminology “validation,” “data type,” or “prompt type” anywhere in its disclosure. Furthermore, the Office Action alleges that because the prompt object includes a question and that Alexander’s surveys are classified by various types (e.g., “political, medical, or product

preference”), the “survey type, thus, is the prompt object type.” Office Action at p. 6. This is clearly an improper assumption because the prompt object, as claimed, comprises both a “question” and a “prompt type.” Under the Office’s logic, the question is the *same* as the prompt type. This is clearly distinguishable from the claimed invention because the prompt object of claim 1 includes both a prompt type and a question. Fig. 14 of the present application clearly shows prompt types according to an exemplary embodiment.

Hence, it appears that the Office is arguing that Alexander’s survey *inherently* includes a prompt type and information that validates a “data-type” of the answer. Applicants note that:

“To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).

The cited paragraphs do not, however, disclose that Alexander’s survey necessarily includes a prompt type or a validation property to validate a “data type” of an answer. Rather, paragraphs [0027], [0029], and [0034] merely indicate that a user may: (1) “only select one of the possible answers;” (2) select “a single suggested answer or to enter a more appropriate answer than those suggested;” (3) select “as many suggested answers as appropriate;” or (4) enter a “free text answer [that] does not provide any suggested answers, but allows the user to enter an appropriate answer.” Nowhere does paragraph [0027], [0029], or [0034] of Alexander explicitly or implicitly teach that the survey includes a *prompt type* and a *validation property* for validating data types of answers. Alexander does not even disclose any component or program validating “data types” of answers, contrary to the assertion made in the Office Action. The Office Action speculates and improperly assumes that Alexander’s survey includes this feature, however, in light of *In re Robertson*, “[i]nherency. . . may not be established by probabilities or possibilities.” *Id.*

Thus, the Office has not shown that Alexander’s survey includes a prompt type *and* a validation property to anticipate the feature of “the prompt object comprising: ... a prompt type; and at least one validation property,” as recited in claim 1. Furthermore, dependent claim 2 clarifies that the “at least one validation property comprises verification that the answer provided

to the question is of the specified prompt type.” Nowhere is this taught or even mentioned in Alexander. Nevertheless, the Office Action improperly cites paragraphs (e.g., [0027], [0029], and [0034]) to assert that Alexander allegedly teaches these features.

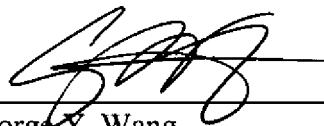
These features are simply not taught or even contemplated by Alexander. For a proper rejection under 35 U.S.C. § 102(e), each and every claim limitation must be shown in a single reference. The Office Action has failed to meet this requirement and thus the rejection is unsupported and should be withdrawn.

The Office Action has cited additional references, which were considered pertinent but not relied upon. Neither of these cited references cure the deficiencies of Alexander nor render obvious the claimed invention, as described above.

Claims 2-5, which depend from claim 1, also allowable due to their dependence on an allowable claim. Independent claims 6, 14, and 21 are allowable for reasons analogous to those given in support of claim 1. Claims 7-13, 15-20, and 22-28, which respectively depend from claims 6, 14, and 21, also are in condition for allowance due to their dependence on an allowable claim.

Thus, in view of the foregoing, an appeal on that basis will certainly succeed, but the time and expense in preparing an appeal brief on that issue should not be borne by MicroStrategy when the grounds is so clearly improper.

Respectfully submitted,



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